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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------|-------------|----------------------|-----------------------|------------------|
| 09/764,673 | 01/18/2001 | Ram K. Ramesh | D-42035-06 | 8627 |
| 28236 | 7590 | 10/09/2003 | | EXAMINER |
| | | | HARMON, CHRISTOPHER R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3721 | |
| DATE MAILED: 10/09/2003 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/764,673 | RAMESH ET AL. | |
| | Examiner | Art Unit | |
| | Christopher R Harmon | 3721 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 August 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 29-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 29-48 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 29-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Terms such as "first polyamide" (claim 29, line 15; claim 48, line 7), "second polyolefin", "second polyamide" (claim 29, lines 17-18); "thickness of at least about 5% of a total thickness" (claim 29, line 20); "of at least 90 degrees" (claim 33, lines 2-3); "at least 9 percent" (claim 34, line 3); "of from about 5 to 20 percent" (claim 41, line 1), etc. are indefinite and unclear.

A first polyolefin has been defined in claim 29 as one of a specified group (or combination thereof) however when further classifying another group to be selected from "first polyamide" is not specific. "of at least about" and "of from about" are indefinite due to the use of "about".

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 29-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (US 3,130,647) in view of Schirmer (US 4,448,792).

Anderson et al. disclose a process for making a backseamed casing comprising preparing a multilayer heat shrinkable film, wrapping the film longitudinally around a forming shoe with opposing edges overlapped and sealed forming a backseam while forwarding the film; see figure 13. Anderson discusses varying the thickness of at least one ply of the multilayer web; see column 3, lines 10-15 and lists possible materials such as "polyethylene, styrene, nylon, vinylidene and chloride fluorocarbon plastic being representative, but not exclusive.", column 4, lines 7-8. Therefore, it would have been obvious to one of ordinary skill in the art to select a plastic such as an anhydride-containing polyolefin with at least 1 percent weight anhydride as a matter of design choice or any other polymer.

Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Anderson et al. does not directly disclose three to six layers of film forming the multilayer film, however Schirmer teaches constructing a thermoplastic heat shrinkable multilayer (six layers) bag, see figures 1 and 2. Schirmer also teaches oxygen barrier layer 14 comprising polyvinylidene chloride copolymer. The casing film shrinks in near boiling water or 185 degrees F, see column 4, lines 43-45.

Regarding claim 32, Schirmer discloses using propylene homopolymers or copolymers for a specific layer (see column 3, lines 58-67).

Regarding claim 38, layers 12 (second) and 14 (fourth) are adhered by (third) layer 13 which can be a crosslinked polymer network (see column 3, lines 62-3).

Regarding claim 45, Anderson et al. disclose a lap seal (figure 2).

The examiner takes **OFFICIAL NOTICE** that limitations such as vicat softening points of 90 degrees (claim 33), 9% by weight of unsaturated acid mer present (claim 34), variations of layering, etc. are obvious design choices and at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the desired polymer layer.

One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the disclosed teachings of Anderson et al. and Schirmer because all of the method steps of forming the backseal have been anticipated.

Furthermore, concerning the thickness ranges and specific percentages of weight it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

5. Applicant's arguments filed 3/26/03 have been fully considered but they are not persuasive. Anderson discloses a multilayer film comprised of polymers and varying thickness; see column 3, lines 10-15. In response to applicant's argument that a multilayered film with an internal layer of at least 5% of the overall thickness, the test

for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Regarding some of the claim limitations (ie. Vicat softening points of degrees, etc.) it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3721

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R Harmon whose telephone number is 703-308-8643. The examiner can normally be reached on Monday-Thursday from 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 703-308-2187. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ch



EUGENE KIM
PRIMARY EXAMINER